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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,351	02/06/2004	Douglas F. Reynolds	1033-LB1011	5256

			EXAMINER
60533	7590	12/05/2006	GAUTHIER, GERALD

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ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/774,351	REYNOLDS ET AL.
	Examiner	Art Unit	
	Gerald Gauthier	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 September 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-53</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-53</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 31, 32 and 48-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer readable-medium does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). The claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result).

See the following link: http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   **Claim(s) 1-53** are rejected under 35 U.S.C. 102(e) as being anticipated by Koser

et al. (US 2004/0032946 A1).

Regarding **claim(s) 1**, Koser discloses a call indication method (paragraph 0002)

comprising:

recognizing a request to complete a voice over internet protocol call to a called

party (paragraph 0117);

receiving custom ring information from a calling party of the VoIP call, the custom

ring information representing a desired ring tone to be played to the called party

(paragraph 0117); and

initiating delivery of the custom ring information to the called party (paragraph

0118).

Regarding **claim(s) 2**, Koser discloses a call indication method, further comprising utilizing a Public Switched Telephone Network node to perform at least one of the recognizing step, the receiving step, and the initiating step (paragraph 0103).

Regarding **claim(s) 3**, Koser discloses a call indication method, further comprising recognizing that a piece of customer premises equipment associated with the called party comprises specialized ring tone functionality operable to output the desired ring tone (paragraph 0107).

Regarding **claim(s) 4**, Koser discloses a call indication method, further comprising delivering at least a portion of the custom ring information in VoIP packets (paragraph 0117).

Regarding **claim(s) 5**, Koser discloses a call indication method, further comprising delivering the custom ring information across a wireline connection comprising a link of coaxial cable operable to carry data traffic (paragraph 0117).

Regarding **claim(s) 6**, Koser discloses a call indication method, wherein a VOIP switch initiates delivery of the custom ring information to the called party (paragraph 0117).

Regarding **claim(s) 7 and 38**, Koser discloses a call indication method, further comprising: prompting the calling party to communicate the custom ring information (paragraph 0117); and

recording the custom ring information (paragraph 0117).

Regarding **claim(s) 8**, Koser discloses a call indication method, further comprising utilizing a piece of calling party CPE to perform at least one of the recognizing step, the receiving step, and the initiating step (paragraph 0118).

Regarding **claim(s) 9, 28 and 45**, Koser discloses a call indication method, wherein at least a portion of the custom ring information has a file format selected from the group consisting of a .WAV file, a .MIDI file, and a .AU file (paragraph 0118).

Regarding **claim(s) 10, 39, 52 and 53**, Koser discloses a call indication method, wherein at least a portion of the custom ring information represents a spoken message (paragraph 0120).

Regarding **claim(s) 11 and 40**, Koser discloses a call indication method, wherein recognizing the request to complete the VOIP call occurs after receiving the custom ring information (paragraph 0118).

Regarding **claim(s) 12 and 41**, Koser discloses a call indication method, further comprising storing the custom ring information in a memory residing in a piece of calling party customer premises equipment (paragraph 0107).

Regarding **claim(s) 13, 37 and 42**, Koser discloses a call indication method, further comprising storing the custom ring information in a memory located within a service provider network (paragraph 0107).

Regarding **claim(s) 14**, Koser discloses a call indication method, further comprising: recognizing caller identification information of the calling party (paragraph 0117); and

finding a location in the memory that is storing the custom ring information (paragraph 0117).

Regarding **claim(s) 15, 34 and 49**, Koser discloses a call indication method, further comprising: recognizing another request to complete a second VOIP call to a second called party (paragraph 0117); and

determining that a second called party does not want to receive the custom ring information (paragraph 0117).

Regarding **claim(s) 16, 35, 46 and 50**, Koser discloses a call indication method, further comprising blocking delivery of the custom ring information to the second called party (paragraph 0117).

Regarding **claim(s) 17 and 36**, Koser discloses a call indication method, further comprising: receiving Caller Identification information associated with the second VOIP call (paragraph 0117); and

using the Caller Identification information to determine that the second called party does not want to receive the custom ring information (paragraph 0117).

Regarding **claim(s) 18**, Koser discloses a ring tone delivery system (paragraph 0002), comprising:

an interface operable to receive a calling signal that indicates a request to complete a call from a calling party to a called party (paragraph 0117); and

a network node communicatively coupled to the interface and operable to deliver packetized information representing a calling party selected ring tone to the called party (paragraph 0118).

Regarding **claim(s) 19**, Koser discloses a ring tone delivery system, wherein the network node comprises a VOIP switch operable to communicatively couple to a plurality of subscribers across links comprising twisted pair wiring (paragraph 0103).

Regarding **claim(s) 20**, Koser discloses a ring tone delivery system, further comprising a memory maintaining information indicating that the called party has a piece of telephonic equipment capable of outputting the calling party selected ring tone, wherein the piece of telephonic equipment is selected from a group consisting of a computer, a telephone communicatively coupled to a twisted pair network, a cordless telephone, a VOIP telephone, a cellular telephone, a fixed wireless telephone, and an 802.1 1 telephone (paragraph 0117).

Regarding **claim(s) 21**, Koser discloses a ring tone delivery system, wherein the network node is further operable to deliver packetized information across a cable network (paragraph 0117).

Regarding **claim(s) 22**, Koser discloses a ring tone delivery system, wherein the network node is further operable to deliver packetized information across an XDSL network (paragraph 0117).

Regarding **claim(s) 23**, Koser discloses a ring tone delivery system, further comprising a custom ring tone block list indicating that a second called party does not want to receive the calling party selected ring tone (paragraph 0124).

Regarding **claim(s) 24**, Koser discloses a ring tone delivery system, further comprising a broadband modem providing at least a portion of a link communicatively coupling the network node to a piece of telephonic equipment associated with the called party (paragraph 0117).

Regarding **claim(s) 25**, Koser discloses a ring tone delivery system, further comprising a memory maintaining information indicating an additional communication address for the called party, the additional communication address selected from the group consisting of an electronic mail address, a Plain Old Telephony Service telephone number, an Instant Messaging address, a Short Messaging Service address, an Enhanced Messaging Service address, a Multimedia Messaging Service address, and a wireless telephone number (paragraph 0118).

Regarding **claim(s) 26**, Koser discloses a system for facilitating a select ring tone in connection with a call (paragraph 0002), comprising:

an electronic device operable to support telephonic communication, the electronic device comprising a housing component (paragraph 0117);

a memory located within an enclosure at least partially formed by the housing component, the memory storing ring tone information representing the select ring tone (paragraph 0117);

a user interface for the electronic device operable to receive a user input indicating a desire to place a call to a called party (paragraph 0117); and

an output engine operable to initiate communication of the ring tone information

to the called party such that a telephonic device of the called party outputs the select

ring tone to indicate the call (paragraph 0118).

Regarding **claim(s) 27 and 44**, Koser discloses a system, wherein the electronic

device comprises a computer (paragraph 0117).

Regarding **claim(s) 29**, Koser discloses a system, wherein the memory stores

additional ring tone information representing a second select ring tone, further wherein

the select ring tone is associated with the called party and the second select ring tone is

associated with a different party (paragraph 0117).

Regarding **claim(s) 30 and 47**, Koser discloses a system, further comprising an

electronic address book comprising a listing for the called party and a second listing for

the second party (paragraph 0117).

Regarding **claim(s) 31**, Koser discloses a computer-readable medium having

computer-readable data to maintain information representing a calling party selected

ring tone (paragraph 0002), to recognize an event trigger signaling a request to place a

VoIP call from the calling party to a called party (paragraph 0117), to initiate completion

of the VoIP call, and to direct delivery of the information to a telephonic device of the

called party in a format that allows the telephonic device to output the calling party,

selected ring tone as an indication of an incoming call (paragraph 0118).

Regarding **claim(s) 32 and 51**, Koser discloses a computer-readable medium

having additional computer-readable data to determine if the called party desires

delivery of the information (paragraph 0117).

Regarding **claim(s) 33**, Koser discloses a call indication method (paragraph

0002) comprising:

recognizing a request to complete a call to a called party over a packet switch

network (paragraph 0117);

receiving first custom ring information from a calling party of the call, the first

custom ring information representing a desired ring tone to be played to the called party

(paragraph 0117); and

determining not to play the first custom ring information to the called party

(paragraph 0124).

Regarding **claim(s) 43**, Koser discloses a system for facilitating a select ring tone

in connection with a call (paragraph 0002), comprising:

an electronic device operable to support telephonic communication, the

electronic device comprising a housing component (paragraph 0117);

a memory located within an enclosure at least partially formed by the housing component, the memory storing zing tone information representing the select ring tone and including an advertisement (paragraph 0117);

a user interface for the electronic device operable to receive a user input indicating a desire to place a call to a called peaty (paragraph 0117); and

an output engine operable To initiate communication of the ring tone information to the called party such that a telephonic device of the called party outputs the select ring tone to indicate the call (paragraph 0118).

Regarding **claim(s) 48**, Koser discloses a computer-readable medium having computer-readable data (paragraph 0002) to:

maintain information representing a calling party selected ring tone (paragraph 0117);

recognize an event trigger signaling a request to place a VoIP call from the calling party to a called party (paragraph 0117);

initiate completion of the VoIP call (paragraph 0117);

direct delivery of the information to a telephonic device of the called party in a format that allows the telephonic device to output the calling party selected ring tone as an indication of an incoming call (paragraph 0118); and

determine not to play the calling party selected ring tone (paragraph 0124).
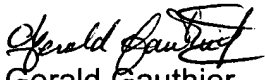
Response to Arguments

4.   Applicant's arguments with respect to **claim(s) 1-53** have been considered but

are moot in view of the new ground(s) of rejection.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-

7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerald Gauthier
Primary Examiner
Art Unit 2614

GG
December 1, 2006